UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,591	12/14/2001	Lesa Satchell	S1342/7000 RJP	5698

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EXAMINER
HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	10/020,591	SATCHELL ET AL.
	Examiner	**Art Unit**
	Jennifer I. Harle	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 December 2001_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-32_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claims 1-32 are pending. Claims 1-32 are rejected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 30 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to or includes within its scope a human being and thus is not considered to be patentable subject matter under 35 U.S.C. 101. *See In re Wakefield*, 422 F.2d 897, 164 U.S.P.Q. 636 (CCPA 1970). The claim recites that the system performs matching by a human operator, thus making the human an integral component of the structure of the system/apparatus.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims "**the initiating occurs** at a location separate from the vendor's place of business" which refers back to claim 21 where there are two different initiating steps, i.e. the user initiating, from a terminal, an order from a web site affiliated with a vendor or the vendor initiating shipment of the order to the customer, from a location separate from the business. For purposes of this Action, the examiner is interpreting the initiating step to be the same as claim 32, i.e. the initiating of the order.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4-7, 9-10, 12, 19 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated

by Mital (5,903,652).

Mital discloses a computer-readable medium with instructions recorded thereon, which

instructions, that when executed, cause at least one processor in communication with a web site to

(Abstract; Figs. 1-15; cols. 3-6):

Accept a data object from the web site describing an order (Figs. 1-15; cols. 3-5 and 7 –

web site = electronic mall; data object = secure purchase order message); and

Transmit a notification upon receipt of payment for the order to initiate order fulfillment

(col. 6).

Mital further discloses that the instructions define the acceptance of the data object further

include instructions defining accepting the data object through a communication channel (Figs. 1-

15; cols. 3-5, 7-8 – secure purchase order message sent through publicly accessible on-line

network through to the specified merchant).

Mital further discloses that the instructions define accepting the objection further defines

creating a self-contained module incorporating data and the processing to be performed on the data

(Figs. 1-15; cols. 3-6 and 7-8 – secure purchase order which is encrypted).

Mital further discloses that the instructions define accepting the data object further define

loading the data object to an electronic file storage (Figs. 1-15; cols. 3-6; cols. 13-14).

Mital discloses a computer-readable medium with instructions recorded thereon, which instructions, that when executed, cause at least one processor in communication with a web site to (Abstract; Figs. 1-15; cols. 3-6):

Accept a first data object from the web site describing an order requiring shipment (Figs. 1-15; cols. 3-5 and 7 – web site = electronic mall; data object = secure purchase order message);

Accept a second data object from a point-of-sale module indicating a payment having been received for the order (cols. 14-15, 26, 29-30 – describes the POS module creating the credit authorization response);

Match the first and second object according at least one data element common to both objects (cols. 14-15, 26, 29-30); and

Transmit notification that a fulfillment operation is to commence (cols. 14-15, 26, 29-30).

Mital further discloses that the instructions define the acceptance of the first data object further include instructions defining accepting the first data object through a communication channel (Figs. 1-15; cols. 3-5 and 7-8 – data channel includes publicly accessible online network through to specified merchant).

Mital further discloses that the instructions define accepting the first data object further define loading the first data object to an electronic file storage (Figs. 1-15; cols. 3-6; cols. 13-14).

Mital further discloses that the instructions define the acceptance of the second data object further include instructions defining accepting the second data object through a communication channel (Figs. 1-15; cols. 14-15, 26, 28-30 – as there is interaction between different modules there is a path or link through which the information passes between two devices, either internally or externally, the definition of a data channel).

Mital further discloses that the instructions define accepting the second data object further define loading the second data object to an electronic file storage (Figs. 1-15; cols. 3-6; cols. 13-14; cols. 28-30).

Method claim 19 is rejected for the same reasons set forth in computer readable medium claim 6.

System claim 29 is rejected for the same reasons set forth in computer readable medium claim 6. The "means for" language has been given the broadest reasonable interpretation and corresponds to the elements of claim 6. The examiner notes that the phrase "means for" was merely inserted before each claim element of claim 6.

4. Claims 13-15, 17-18, 21-25, 27-28, and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Brian Alexander, The Kiosk, Where Brick Meets Click, The New York Times, December 13, 2000, pg. H18.

Alexander discloses a method for executing a transaction (a kiosk) comprising:

From a location at a vendor's place of business, a user initiating, from a terminal, an order from a web site affiliated with the vendor (kiosks located in a vendors place of business and linked to the vendor's web site enabling the customer to order merchandise directly - Store of Knowledge; Borders Kiosk where the web site is accessed through the intranet);

The vendor accepting payment from the user, at the place of business, in return for the order (Store of Knowledge where the kiosk in the vendors store, i.e. accepts payment in return for the order, Borders where the title was located by the kiosk but not found in the store and instructions were provided to go to in information desk to special order it); and

The vendor initiating shipment of the order to the customer, from a location separate from the place of business (Store of Knowledge's kiosk has merchandise shipped from a different

location for items the store does not stock and Border's special orders the books as they are not in stock at that location).

Alexander further discloses that when the user initiates the order it further includes transmitting data describing the order from the web site to a computer operated by the vendor for point-of-sale processing (Store of Knowledge's Kiosk links to a web site and allows purchases, i.e. transmits data to a computer operated by the vendor for point-of-sale processing, either by the Kiosk or Internet; Border's discloses that new kiosks will allow customers to swipe a credit card into a kiosk to pay for special orders and then have them shipped anywhere, i.e. the vendor's kiosk will transmit the order information to POS processing).

Alexander further discloses that the transmission of data includes that the data is transmitted over a communication channel (As both Store of Knowledge and Border's transmit data either internally within the kiosk or externally, there is interaction between different modules, i.e., there is a path or link through which the information passes between two devices, either internally or externally, the definition of a data channel).

Alexander further discloses that when the vendor accepts payment it further includes transmission that notification of received payment to a software module which performs fulfillment processing (Border's discloses that after the credit card is used to pay for the order, i.e. receipt of payment by a software module, the gifts can be shipped anywhere, performing order fulfillment; Store of Knowledge – ordered the gifts, i.e. paid for them and picked them up at a store nearby, software module fulfills order after payment).

Alexander further discloses that the transmission of the notification further includes transmission of notification over a communication channel (notification implicitly occurs over a communication channel because it is data being transmitted between different modules/

servers/components and thus there is some medium for transferring information/carrying data in either analog or digital form – can be a physical link, such as the cable connecting two stations in a network, or it can consist of some electromagnetic transmission on one or more frequencies within a bandwidth, etc. – the definition of a communication channel).

Method claim 21 is rejected for the same reasons set forth in method claim 13.

System claim 31 is rejected for the same reasons set forth in method 21. The "means for" language has been given the broadest reasonable interpretation and corresponds to the elements of claim 21. The examiner notes that the phrase "means for" was merely inserted before each claim element of claim 21.

Alexander further discloses that the initiating occurs at a location separate from the vendor's place of business (Store of Knowledge's kiosk has merchandise shipped from a different location for items the store does not stock and Border's special orders the books as they are not in stock at that location).

System claim 32 is rejected for the same reasons set forth in method claim 22. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 22. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 22 and is broader in that it further comprises.

System claim 23 is rejected for the same reasons set forth in method claim 13. The "means for" language has been given the broadest reasonable interpretation and corresponds to the elements of claim 13. The examiner notes that the phrase "means for" was merely inserted before each claim element of claim 13.

System claim 24 is rejected for the same reasons set forth in method claim 14. The "means for" language has been given the broadest reasonable interpretation and corresponds to the

element of claim 14. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 14 and is broader in that it further comprises.

System claim 25 is rejected for the same reasons set forth in method claim 15. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 15. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 15 and is broader in that it further comprises.

System claim 27 is rejected for the same reasons set forth in method claim 17. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 17. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 17 and is broader in that it further comprises.

System claim 28 is rejected for the same reasons set forth in method claim 18. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 18. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 18 and is broader in that it further comprises.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mital (5,903,652).

Mital teaches as set forth above in claim 6 that teaches the use of a structural matching.

However, Mital does not teach that the matching is performed by a human operator. Method

claim 20 merely claims that the matching is performed by at least one human operator. This

limitation is not given patentable weight because in order for it to be entitled o such weight in

method claims, the recited structural limitation therein must affect the method in a manipulative

sense and not amount to the mere claiming of a use of a particular structure. *See Ex parte Pfeiffer*,

135 USPQ 31, BdPatApp & Int 1961. The structural limitation in the instant method claims does

not affect the matching manipulatively whether by human or by machine. As per system claim 30,

it was well known at the time of the invention that merely providing an automatic means to

replace an automatic activity which accomplishes the same result is not sufficient to distinguish

over the prior art, *In re Venner*, 262 F.2d 91,95, 120 USPQ 193,194 (CCPA 1958). Thus, it

follows that deautomating the step of matching, i.e. have the step performed by a human operator,

provides the same advantages it previously provided prior to automation – a system that is always

working (no network problems/computer errors), interactive client/customer exchanges to build

valuable relationships and creates additional opportunities for cross-selling/upselling, etc. It is an

analogous alternative. In other words, there is no enhancement found in the claimed step other

than the previously known advantages. The end result is the same as the compared automated

method. It would have been obvious to a person of ordinary skill in the art at the time of the

invention to utilize a human in the matching step because this would benefit the vendor for the

reasons set forth above and was previously being done.

6. Claims 3, 8, 11, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

    Mital (5,903,652) or Brian Alexander, The Kiosk, Where Brick Meets Click, The New York

Times, December 13, 2000, pg. H18 in view of Frank J. Derfler, Jr. & Les Freed, How

Networks Work, , September 2000, pp. 200-201 and 206-207.

Mital and Alexander disclose as set forth above. However, neither Mital nor

Alexander disclose the use of network firewalls in conjunction with computer readable media and

instructions for transmitting data objects across them/transmitting data over a communication

channel across a network firewall. Derfler, Jr. discloses that the purpose of a firewall is to

securely separate the Internet and other external network for corporate lans and that firewalls use

several different techniques to inspect the content, not just the destination of incoming packets to

determine whether they warrant access (pg. 200). Derfler, Jr. further discloses that a firewall can

be a function included in software running on a special server, which is available for a variety of

operating systems and sets forth the best configuration as at least three parts (Internet, connection

lan adapter, corporate lan adapter, lan adapter linking firewall to protect lan) because this gives

the firewall total control over the routing of each or these packets. (pg. 200) and that the network

administrator can configure the firewall to deny access to many kinds of data, in order to improve

the security of the system and remove possible holes in the firewall (pg. 200). Derfler, Jr. further

teaches that firewalls protect networks against hackers and assist in eliminating the threat to data,

thus protecting monetary stakes (pp. 206-207). Thus, it would have been obvious to one or

ordinary skill in the art to have included the use of network firewalls in conjunction with computer

readable media and instructions for transmitting data objects across them/transmitting data over a

communication channel across a network firewall in the computer readable medium, method and

system claims of Mital and the method and system of claims of Alexander for the specific reasons

set forth above.

System claim 26 is rejected for the same reasons set forth above as applied to method claim 16. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 16. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 16 and is broader in that it further comprises.

Conclusion

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"[1] the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,[2] the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.[3] By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to

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[1] Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

[2] E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

[3] See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Ione Harle
May 12, 2004